

### **REMARKS/ARGUMENTS**

Claims 1 – 8 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner indicated that claim 8 would be allowable if rewritten in independent form; and rejected claims 1 – 7 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent Application Publication No. 2002/0054987 to Yamamoto et al. (hereinafter referred to as “the Yamamoto et al. ‘987 publication”).

By this Response and Amendment, the rejections have been traversed; and allowable claim 8 has been amended to incorporate the features of claim 1. It is respectfully submitted that the above amendments do not introduce any new matter to this application within the meaning of 35 U.S.C. §132.

The amendments to claim 8 are not narrowing but cosmetic, and have not been made to overcome any prior art reference.

### **Rejection Under 35 U.S.C. §102(a)**

The Examiner rejected claims 1 – 7 as being anticipated by the Yamamoto et al. ‘987 publication.

### **Response**

By this Response and Amendment, the rejection to claim 1, and to the claims dependent thereon, is respectfully traversed since all of the features of independent claim 1 are not disclosed, taught or suggested in the cited prior art.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Independent claim 1 recites “[a] stencil printing master comprising: a porous fiber layer; and a porous resin layer formed on one surface of the porous fiber layer, the porous resin layer comprising a thermoplastic resin having a ratio ( $G1/G2$ ) of a storage modulus ( $G1$ ) at 45°C to a storage modulus ( $G2$ ) at 180°C of  $1 \times 10^2$  to  $1 \times 10^4$ , and a peak melting temperature by DSC of 50°C to 150°C.”

The Yamamoto et al. ‘987 publication discloses a microporous stencil sheet for use in stencil printing using a low viscosity ink. The stencil sheet is comprised of an inelastic resin film. Various types of layers can be used in conjunction with the stencil sheet such as a releasing layer to prevent the stencil sheet from being fused to a thermal head, *see the Yamamoto et al. ‘987 publication* at para. [0052], a photoconversion substance layer that reacts to electromagnetic waves, *Id.* at para. [0054], or a thermal transfer layer, parts of which are transferred to the stencil sheet upon application of heat to the thermal transfer layer when the layer is in communication with the stencil sheet. The Yamamoto et al. ‘987 publication is silent with respect to a porous fiber layer.

Therefore, in contrast to the presently claimed invention, the Yamamoto et al. ‘987

publication does not disclose, teach or suggest “a porous fiber layer” as recited in claim 1 of the present application. As mentioned above, the Yamamoto et al. ‘987 publication is completely silent with respect to this feature. The Examiner’s attention seems to be solely directed toward whether the presently claimed “porous resin layer” is disclosed by the prior art. The Yamamoto et al. ‘987 publication discloses a microporous stencil sheet, but does not go any further. It simply does not disclose, teach or suggest a porous fiber layer. As such, the Yamamoto et al. ‘987 publication does not anticipate the presently claimed invention because it does not disclose, teach or suggest “a porous fiber layer.”

In further contrast to the presently claimed invention, it follows from above that the Yamamoto et al. ‘987 publication does not disclose, teach or suggest “a porous resin layer *formed on one surface of the porous fiber layer.*” For the same reasons mentioned above - that the Yamamoto et al. ‘987 publication is completely silent with respect to a porous fiber layer, - the Yamamoto et al. ‘987 does not disclose, teach or suggest “a porous resin layer *formed on one surface of the porous fiber layer*” as recited in claim 1 of the present application. Thus, the Yamamoto et al. ‘987 publication does not anticipate the presently claimed invention for the additional reason that it does not disclose, teach or suggest this feature.

In yet further contrast to the presently claimed invention, the Yamamoto et al. ‘987 publication does not disclose teach or suggest a “porous resin layer comprising a thermoplastic resin having a ratio (G1/G2) of a storage modulus (G1) at 45°C to a storage modulus (G2) at 180°C of  $1 \times 10^2$  to  $11 \times 10^4$ , and a peak melting temperature by DSC of 50°C to 150°C” as recited in claim 1 of the present application. The Examiner cites examples of resin film disclosed in paragraph [0030] of the Yamamoto et al. ‘987 publication and asserts that like

materials contain like properties. Ostensibly, the only similarity the Examiner can identify is that the Yamamoto et al. '987 publication discloses a resin. However, the Yamamoto et al. '987 publication is silent with respect to the specific properties recited in independent claim 1 of the present application and the Examiner has not shown that any of the materials of the cited example inherently possess the ratio of G1/G2 as recited in claim 1 of the present application. Also, the Examiner has not shown that any of the materials of the cited example inherently possess "a peak melting temperature by DSC of 50°C to 150°C" as recited in claim 1 of the present application.

The Examiner is improperly taking Official Notice that the cited example materials have the claimed ratio and peak melting temperature. "If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *MPEP 8<sup>th</sup> ed.* §2144.03(B) (*construing In re Soli*, 317 F.2d 941, 946 (CCPA 1963) and *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943)). The Examiner has not shown that the cited examples of the Yamamoto et al. '987 publication possess the ratio or peak melting temperature as recited in independent claim 1 of the present application. Therefore, the Examiner has not shown that the Yamamoto et al. '987 publication anticipates the presently claimed invention.

Accordingly, for at least the above stated reasons, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

### CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

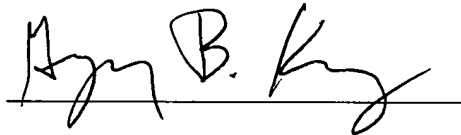
In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,  
**NATH & ASSOCIATES PLLC**

Date: December 1, 2005

NATH & ASSOCIATES PLLC  
1030 Fifteenth Street, N.W.  
Sixth Floor  
Washington, DC 20005  
(202) 775-8383

By:

A handwritten signature in black ink, appearing to read "Gregory B. Kang", written over a horizontal line.

Gary M. Nath  
Registration No. 26,965  
Gregory B. Kang  
Registration No. 45,273  
Derek Richmond  
Registration No. 45,771  
Customer No. 20529